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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,882	09/23/2003	Safaa H. Hashim	021756-060120US	5268
51206 7590 09/29/2010 TOWNSEND AND TOWNSEND AND CREW LLP/ORACLE TWO EMBARCADERO CENTER 8TH FLOOR SAN FRANCISCO, CA 94111-3834				
EXAMINER				
PASS, NATALIE				
ART UNIT		PAPER NUMBER		
3686				
MAIL DATE		DELIVERY MODE		
09/29/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/669,882

Applicant(s)

HASHIM, SAFAA H.

Examiner

Natalie A. Pass

Art Unit

3686

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-6, 8-12, 15-22, 24-28 and 31-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-6, 8-12, 15-22, 24-28 and 31-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 13 July 2010. Claims 1, 7, 13-14, 23, 29-30, 39 have been cancelled. Claims 2, 18, 34-38 have been amended. Grounds of rejection for claims 2-6, 8-12, 15-22, 24-28, 31-38 are set forth in detail below.

Claim Objections

2. The objection to claim 39 under 37 CFR 1.75 is hereby withdrawn due to the amendment filed 13 July 2010.

Claim Rejections - 35 USC § 112

3. The rejection of claims 2-6, 8-12, 15-17, 34-39 under the first paragraph of 35 U.S.C. 112 is hereby withdrawn due to the amendment filed 13 July 2010.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2-6, 8-12, 15-22, 24-28, 31-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Surbey et al. (WO 0225470 A1) and Grover et al., U.S Patent Application

Publication Number 2002/0188484 for substantially the same reasons given in the previous Office Action (paper number 20100409). Further reasons appear hereinbelow.

- (A) Claims 2, 18, and 34 have been amended to include the recitation of
- logic for performing at least one corresponding “post-application” insurance underwriting function at lines 13, 11, and 15, respectively.

As per these newly amended features Surbey and Grover teach a method for facilitating communication in an insurance-underwriting process, as analyzed and discussed in the previous Office Action (paper number 20100409), further comprising logic for performing at least one corresponding “post-application” insurance underwriting function (Surbey; page 11, paragraph 3 to page 12, paragraph 3, page 14, paragraph 4); Examiner interprets Surbey’s teachings of “a computer-aided method for managing a web-enabled and/or computerized collaborative insurance process” that “can include, for each of a plurality of insurance transactions, for each of a plurality of users, automatically creating a plurality of standardized computer document folders consistent with a role of the user in the collaborative insurance process ... [...] ... providing the user with access via a networked computer to the user’s hierarchically organized folder structure and plurality of standardized computer document folders. ... [...] ... The method can ... [...] ... include, for each of the insurance transactions automatically creating a computer-based insurance quotation request based on the insurance data entry template and having a message and a document containing insurance requirements and exposure information, simultaneously sending the computer-based insurance quotation request to a plurality of insurers ... [...] ...” (Surbey; page 12, paragraph 2) and in which “each underwriter can access a uniquely rendered

workspace” (Surbey; page 11, paragraph 3) and which contains “ a broker information device 2100 [that] can be used by a broker to communicate regarding one or more insurance transactions with various other information devices (e.g., client information device 2200, insurer information device . 2300, etc.) and/or with one or more data servers 2700 and/or web/application servers 2800. Broker information device 2100 can also be used to collaborate with others, ... [...] ... enter transaction information, prepare an electronic submission, post the electronic submission, review quotes, select a policy ... [...] ...” (Surbey; page 14, paragraph 4) to include teachings of a form of logic for performing at least one corresponding post-application insurance underwriting function.

As per the remainder of the amendments to claims 2 and 34, these appear to have been made merely to correct errors in the claim language and to overcome rejections under 35 U.S.C. 112, first paragraph. While these changes render the language of the claims smoother and more consistent, they otherwise affects neither the scope and breadth of the claims as originally presented nor the manner in which the claims were interpreted by the Examiner when applying prior art within the previous Office Action. As such, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 20100409, section 8, pages 5-12), incorporated herein.

The remainder of claims 2, 18, and 34 is rejected for the same reasons given in the prior Office Action (paper number 20100409, section 8, pages 5-12), and incorporated herein.

The motivations for combining the respective teachings of Surbey and Grover are as given in the rejection of claim 2 in the previous Office Action (paper number 20100409), and incorporated herein.

(B) As per the amendments to claims 35-38, these appear to have been made merely to correct errors in the claim language and to overcome rejections under 35 U.S.C. 112, first paragraph. While these changes render the language of the claims smoother and more consistent, they otherwise affects neither the scope and breadth of the claims as originally presented nor the manner in which the claims were interpreted by the Examiner when applying prior art within the previous Office Action. As such, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 20100409, section 8, pages 5-12), incorporated herein.

(C) Claims 3-6, 8-12, 15-17, 19-22, 24-28, 31-33 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 20100409, section 8, pages 5-12), and incorporated herein.

Response to Arguments

6. Applicant's arguments filed 13 July 2010 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 13 July 2010.

(A) As per Applicant's argument on pages 10-11 of the response filed 13 July 2010 that the applied references fail to teach "that the on-line quote system includes logic for

performing at least one corresponding post-application insurance underwriting function,” as added to newly amended claim 2, Examiner respectfully disagrees.

Firstly, Examiner submits that Applicant has not claimed “an on-line quote system” but rather “a method for facilitating communication in an insurance-underwriting process,” which includes providing access to participants, storing and organizing data related to insurance underwriting, enabling collaboration, sharing data, determining access to data based on roles, and which also including modules comprising logic for performing post-application insurance underwriting functions, but which does not appear to contain the providing of on-line quotes.

With respect to Applicant’s argument on page 11, paragraph 1 of the response filed 13 July 2010, Examiner notes that the primary Surbey reference teaches

“a computer-aided method for managing a web-enabled and/or computerized collaborative insurance process” that “can include, for each of a plurality of insurance transactions, for each of a plurality of users, automatically creating a plurality of standardized computer document folders consistent with a role of the user in the collaborative insurance process ... [...] ... providing the user with access via a networked computer to the user's hierarchically organized folder structure and plurality of standardized computer document folders. ... [...] ... The method can ... [...] ... include, for each of the insurance transactions automatically creating a computer-based insurance quotation request based on the insurance data entry template and having a message and a document containing insurance requirements and exposure information, simultaneously sending the computer-based insurance quotation request to a plurality of insurers ... [...] ...” (Surbey; page 12, paragraph 2);

and Surbey teaches

“each underwriter can access a uniquely rendered workspace” (Surbey; page 11, paragraph 3);

and Surbey teaches

“ a broker information device 2100 [that] can be used by a broker to communicate regarding one or more insurance transactions with various other information devices (e.g., client information device 2200, insurer information device . 2300, etc.) and/or with one or more data servers 2700 and/or web/application servers 2800. Broker information device 2100 can also be used to collaborate with others, ... [...] ... enter transaction information, prepare an electronic submission, post the electronic submission, review quotes, select a policy ... [...] ...” (Surbey; page 14, paragraph 4).

Further, Examiner submits that the Grover reference teaches

“a method and system for furnishing a real-time, on-line quote to a user for an insurance product, such as auto insurance, which frees up CSR personnel resources to focus on the sale of policies and reduces costs ... [...] ...” (Grover; paragraph [0006])

Accordingly, Examiner submits that the combined applied references do teach a method for facilitating communication in an insurance-underwriting process further comprising logic for performing at least one corresponding post-application insurance underwriting function, as claimed in amended claims 2, 18, and 34, and as argued by Applicant in pages 10-11 of the response filed 13 July 2010

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

8. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

/N. A. P./
Examiner, Art Unit 3686
September 16, 2010

/Gerald J. O'Connor/
Supervisory Patent Examiner
Group Art Unit 3686